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09/851,958	05/10/2001	Arata Tomita	Q64221	4398

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EXAMINER

MAKI, STEVEN D

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

0217

Office Action Summary

Application No.

09/851,958

Applicant(s)

TOMITA, ARATA

Examiner

Steven D. Maki

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 9-11, 15 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 9-11, 15 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1) A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 9-22-03 has been entered.

2) The disclosure is objected to because of the following informalities: In the insertion filed 5-10-01, "This is a divisional of Application No. 09/042,642" should be --This is a continuation of Application No. 09/042,642--.

Appropriate correction is required.

3) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4) Claims 7, 9-11, 15 and 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 11, 18 and 19, it is unclear if a pneumatic tire or a vehicle having a pneumatic tire mounted thereon is being claimed. The description of "A pneumatic tire ..." in the preamble indicates that a pneumatic tire is being claimed. However, the description of "wherein the tire is mounted on a vehicle" in the body of the claim and applicant's corresponding arguments filed 9-22-03 indicate that a vehicle having a pneumatic tire mounted thereon is being claimed. In each of claims 11, 18 and 19, it is

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suggested to (1) change "A pneumatic tire" (line 1) to --A combination of a vehicle and a pneumatic tire-- and (2) change "the tire is mounted on a vehicle" to --the tire is mounted on the vehicle--.

In claim 22, the scope and meaning of "rotating mount" is unclear. It is suggested to change "rotating mount" (both occurrences) to --rim--. Page 5 of the original disclosure describes "rim".

5) The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

(1) Appropriate incorporation of description relating to "tire forward rotational direction" from claims 11, 18, 19 and 22 into the specification;

(2) Appropriate incorporation of the description relating to "the tire is mounted on a vehicle" from claims 11, 18 and 19 into the specification; and

(3) Appropriate incorporation of the description of "vehicle comprising: a rotating mount [rim]; and a pneumatic tire mounted on the rotating mount [rim] for rolling support of the vehicle on the ground" from claim 22 into the specification.

6) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Japan '410

8) **Claims 7, 9-11, 15, 18-19 and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Japan '410 (JP 3-38410).**

Japan '410 discloses a pneumatic tire having a tread including blocks defined by circumferential grooves and transverse grooves wherein the blocks have sipes. See figures 1 and 4. The tread has a non-directional tread pattern. See figures 1 and 4. The footprint of the tire is illustrated in 4. On one side of the tire, the tire has sipes, which at a same axial distance are substantially parallel to the contour of an edge of the footprint or a tangent to the contour of an edge of the footprint. See figure 4. On the other side of the tire, the tire has sipes, which at a same axial distance are substantially parallel to the contour of the other edge of the footprint or a tangent to the contour of the other edge of the footprint. See figure 4. Japan '410's tire, therefore, has sipes, which at a same axial distance are substantially parallel to the contour of the trailing edge of footprint or a tangent to contour of the trailing edge of the footprint.

The claimed vehicle is anticipated by Japan '410. One of ordinary skill in the art would readily understand that Japan '410's tire is mounted on a rim of a vehicle in order

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to be used for its intended purpose. The description of the sipe being in a trailing region of the block fails to require sipe location different from that disclosed by Japan '410.

Smithers Scientific Services, Inc.

9) **Claims 7, 9-11, 15, 18-19 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smithers Scientific Services, Inc. (footprint on page 62, March 31, 1989) and Fontaine (US 5343918).**

Smithers Scientific Services, Inc. appears to be available as prior art under 35 USC 102(a) or (b) since it was cited in (1) the reexam of US 5176766 as "Smithers Scientific Services, Inc., "Footprints", Apr. 30, 1985, etc.", (2) US 5358022 as "Smithers Scientific Services, Inc., random footprints 1985-1989", and (3) US 5503206 as "Smithers Scientific Services, Inc., random footprints 1985-1989".

Page 62 of Smithers Scientific Services, Inc. (dated March 31, 1989) shows a footprint of a pneumatic tire. The footprint demonstrates that the tread of the tire has a nondirectional pattern comprising circumferential grooves, transverse grooves and a pair of shoulder blocks wherein each shoulder block has three sipes. Smithers Scientific Services, Inc. does not recite a vehicle. However, it would have been obvious to mount the tire of Smithers Scientific Services, Inc. on a car since Fontaine, also directed to a tire including shoulder blocks having plural sipes, suggests using such a tire for a car - one of ordinary skill in the art readily understanding that a pneumatic tire is mounted on the rim of a car. On one side of the tire, the tire has sipes, which at a same axial distance are substantially parallel to the contour of an edge of footprint or a tangent to contour of an edge of the footprint. See footprint shown on page 62 of

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Smithers Scientific Services, Inc. On the other side of the tire, the tire has sipes, which at a same axial distance are substantially parallel to the contour of the other edge of the footprint or a tangent to the contour of the other edge of the footprint. See footprint shown on page 62 of Smithers Scientific Services, Inc.. The tire having the footprint on page 62 of Smithers Scientific Services, Inc., therefore, has sipes, which at a same axial distance are substantially parallel to the contour of the trailing edge of the footprint or a tangent to the contour of the trailing edge of the footprint. The claims fail to exclude having such sipes in the leading edge region. As to the dependent claims: The tread pattern is clearly nondirectional as claimed in claim 21. As to claims 9 and 10, the description relating to "inner side" reads on and fails to exclude sipes extending across most of the width of the block as indicated by the footprint on page 62 of Smithers Scientific Services, Inc. As to claims 7 and 15, it would have been an obvious to use more than two rows of blocks while satisfying the limitation regarding the sipe being substantially parallel to trailing edge in view of (1) the orientation of the sipes and leading and trailing edges of the footprint shown on page 62 of Smithers Scientific Services, Inc. and (2) Fontaine's suggestion to use four block in a non-directional tread (figure 2).

Allowable Subject Matter

10) **Claim 20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.**

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Claim 20 differs in scope from the claims of US 6283184 (the patent issuing from parent application 09/042642) since claim 20 requires a combination of vehicle and a tire whereas the claims in US 6283184 do not require the vehicle.

Remarks

11) Applicant's arguments with respect to claims 7, 9-11, 15 and 18-22 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 9-22-03 have been fully considered but they are not persuasive.

The prior art rejection using Japan '204 has been withdrawn in view of the amendment filed 9-22-03. There is no motivation to mount Japan '204's tire such that the sipes are parallel to the trailing edge of the footprint instead of the leading edge of the footprint.

12) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is 703-308-2068 until Dec. 18, 2003 and (571) 272-1221 after Dec. 18, 2003. The examiner can normally be reached on Mon. - Fri. 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Steven D. Maki
November 29, 2003


STEVEN D. MAKI
PRIMARY EXAMINER
~~GROUP 1300~~
Art 1733
11-29-03